

DETAILED ACTION

1. Claims 1, 3, and 5-23 are pending in the application.
2. In the prior action, mailed on January 27, 2010, claims 1-23 were pending; with claims 5-23 withdrawn from consideration; and claims 1-4 under consideration and rejected.
3. In the Response of June 4, 2010, the Applicant cancelled claims 2 and 4, and amended claims 1 and 3.
4. Claims 1 and 3 are under consideration.

Claim Rejections - 35 USC § 112

5. **(Prior Rejection- Withdrawn)** Claims 2 and 4 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the cancellation of the claims, the rejection is withdrawn.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **(Prior Rejection- Maintained)** Claims 1-4 were rejected under 35 U.S.C. 102(b) as being anticipated by Nakatani et al. (WO 98/03652). The rejection is withdrawn from cancelled claims 2 and 4.

Claims 1 and 3 have been amended to read on nucleic acids encoding peptides consisting of about 21-40 amino acids "consisting essentially of a ZA loop of a bromodomain consisting essentially of the amino acid of" SEQ ID NO: 3 or SEQ ID NO: 7. It is noted that the MPEP states that "absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, 'consisting essentially of' will be construed as equivalent to 'comprising.'" MPEP § 2111.03. It is noted that the present application does not appear to provide any clear indication as to what is intended to be excluded or included by the language "consisting essentially of." The claims are therefore read as though still reading on nucleic acids encoding a polypeptide comprising a ZA loop of SEQ ID NO: 3 or SEQ ID NO: 7.

Because the claims do not appear to be limited to sequences encoding polypeptides consisting of the ZA loop, and as neither the claims nor the specification indicate what is intended to be excluded by use of the language "consisting essentially or" in the claims as amended, and as the sequence taught by the reference includes the ZA loop of SEQ ID NO: 7, the Applicant's arguments are not found persuasive.

The rejection is therefore maintained with respect to claims 1 and 3.

8. **(Prior Rejection- Withdrawn)** Claims 1 and 2 were rejected under 35 U.S.C. 102(a) as being anticipated by Dhalluin et al. (Nature 399:491-96- reference of record in the September 2000 IDS). In view of the declaration of Dr. Zhou on June 1, 2010 under 37 CFR 1.131, this rejection is withdrawn.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **(Prior Rejection- Maintained)** Claims 3 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nakatani as applied above in view of Malcolm et al.(EP 0124221). The rejection is withdrawn from cancelled claim 4. Applicant traverses the rejection on the same basis as asserted with respect to the rejection of the claims as anticipated by the reference above. In addition to the response indicated above with respect to the rejection under 35 USC 102(b), it is also noted that the reference would have rendered obvious any fragment of the nucleic acid that could be used as a probe to the nucleic acid of SEQ ID NO: 2 of the reference- including a fragment encoding the ZA loop. The fact that this fragment would not have been recognized as encoding the ZA loop does not render the otherwise obvious probe non-obvious. See e.g., MPEP § 2145.II. Rather, the Applicant has merely identified an additional characteristic of this otherwise obvious fragment of SEQ ID NO: 2. The rejection is therefore maintained for the reasons indicated above, and for the reasons of record.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Conclusion

12. No claims are allowed.
13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zachariah Lucas whose telephone number is (571)272-0905. The examiner can normally be reached on Monday-Friday, 8:30 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert B. Mondesi can be reached on 571-272-0956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Zachariah Lucas/
Primary Examiner, Art Unit 1648